

REMARKS

Claims 2, 6-9, and 21-50 are pending in this Application.

The Office action mailed 25 April 2001 (Paper No. 9) provided by the examiner has been read and given careful consideration. The applicant appreciates the time invested by examiner Ali Zamani in the preparation of Paper No. 9.

A. Rejection of Previously Allowed Claims 2, 6, 7, 8, and 9

On page 3 of the Office action mailed 11 November 2000 (Paper No. 7), the examiner states that "Claims 2 and 6-9 are allowed." However, in the Office action mailed 25 April 2001 (Paper No. 9), the examiner rejects claims 2 and 6-9 without addressing the fact that these claims were previously allowed. It appears that the examiner has not acted in accordance with the M.P.E.P. § 706.04.

The M.P.E.P. § 706.04 indicates the following. "Because it is unusual to reject a previously allowed claim, the examiner should point out in his or her letter that the claim now being rejected was previously allowed by using Form Paragraph 7.50."

Surprisingly, the Form Paragraph 7.50 does not appear anywhere in Paper No. 9. In addition, there is no text in Paper No. 9 which is roughly the equivalent of Form Paragraph 7.50.

The M.P.E.P. § 706.04 also states the following. "A claim noted as allowable shall thereafter

be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action. **Great care** should be exercised in authorizing such a rejection. See *Ex parte Grier*, 1923 C.D. 27; 309 O.G. 223; *Ex parte Hay*, 1909 C.D. 18; 139 O.G. 197.” The applicant cannot be sure that the examiner has exercised “**great care**” in accordance with M.P.E.P. § 706.04. In addition, it is not clear whether the proposed rejection was submitted to the primary examiner for consideration of all the facts.

In view of the foregoing, the applicant respectfully requests a prompt and full explanation as to why previously allowed claims were rejected in this case, in accordance with the M.P.E.P.

B. 35 U.S.C. § 103

On page 2 of Paper No. 9, the examiner rejects claims 2, 6-9, and 21-50 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,608,418 issued to McNally in view of U.S. Patent No. 6,097,364 issued to Miyamoto et al. The applicant respectfully traverses.

This rejection is severely flawed.

To establish a *prima facie* case of obviousness, for a rejection of claims under 35 U.S.C. § 103, three basic criteria must be met. **First**, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there must be a reasonable expectation of success. **Third**, the prior art reference (or references when combined) must teach or

suggest all the claim limitations. See the *Manual of Patent Examining Procedure* (M.P.E.P.) §§ 706.02(j) and 2143, and 35 U.S.C. § 103. If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

McNally '418 describes a computer system that can be coupled to two different types of display monitors. The McNally '418 device can be coupled to either a cathode ray tube or a flat panel display, for example. McNally '418 states that existing application programs do not need to be modified for either type of display because of the disclosed graphics subsystem which is compatible with both a cathode ray tube and a flat panel display. In column 1 at lines 50-58, McNally '418 describes the problems that the McNally '418 device is designed to solve. "Existing high resolution computer graphics systems typically require major modifications to the graphics subsystem to accommodate the lower resolution flat panel displays....Such modifications increase the cost of developing smaller and lighter weight computer graphics systems."

Miyamoto '364 describes a display control apparatus which compresses image data to reduce the size of a display memory (column 1 at lines 1-5). In column 3, objectives of the Miyamoto '364 device are set forth. Three objectives are described as being "to reduce a memory capacity required to detect a partial area to be rewritten in a field", "to provide a method of configuring a system of pseudo halftone process, partial writing and multi-interlace scan", and "to introduce a technique of image data separation for discriminating a character/fine line area and a natural image having halftone, into a display system" (column 3 at lines 1-24). Miyamoto '364 describes a way to reduce a size of a memory. Miyamoto '364 states that "since the image data of the previous frame which

is necessary for detecting the area in the displayed image in which the partial writing is to be done is retained as the compressed data, the memory capacity can be reduced and the configuration of the display control apparatus can be simplified” (column 6 at lines 23-28). Figure 1 of Miyamoto '364 shows a computer 2 connected to a cathode ray tube (CRT) 15 and a display panel unit 3. The Miyamoto '364 device suggests that an analog CRT signal for CRT 15 can be converted to a digital display signal and then displayed by display panel unit 3 (column 5 at line 27 through to column 6 at line 63).

McNally '418 does not teach connecting a video display unit to a computer system after the computer system has been powered on. Miyamoto '364 does not teach connecting a video display unit to a computer system after the computer system has been powered on. Also, the examiner's proposed combination of McNally '418 and Miyamoto '364 fails to teach connecting a video display unit to a computer system after the computer system has been powered on.

In fact, there is not even a scintilla of subject matter in either of these two references which teaches or suggests connecting a video display unit to a computer system **after** the computer system has been powered on, as set forth in the applicant's claims 21-50.

The independent claims 2 and 6-9 each set forth “a method, comprising: while power is being supplied to a processing unit, detecting whether a video display unit is newly coupled to a connecting unit of said processing unit” and at least one selected from a polling operation and an interrupt signal, *inter alia*. The examiner's proposed combination of McNally '418 and Miyamoto

'364 fails to teach or suggest these features of the claimed invention.

Among the claims 21-50, the claims 21, 26, 31, 36, and 43 are independent claims. Each of these independent claims clearly sets forth that a video display unit is connected to a computer system **after** the computer system has been powered on. The examiner's proposed combination of McNally '418 and Miyamoto '364 fails to teach or suggest this feature and others of the claimed invention.

Claim 21 sets forth "connecting a video display unit to a computer system after said computer system has been powered on and initialized". Claim 26 sets forth "connecting a video display unit to a computer system after said computer system has been initialized and while said computer system is being operated by a user".

Claim 31 sets forth "connecting a video display unit to a computer system after said powering on of said computer system". Claim 36 sets forth "said video display unit being connected to said computer system after said computer system has been powered on and initialized". Claim 43 sets forth "said video display unit being connected to said computer system after said computer system has been booted".

The examiner's proposed combination of McNally '418 and Miyamoto '364 fails to describe connecting a video display unit to a computer system after the computer system has been powered on, as set forth in independent claims 21, 26, 31, 36, and 43. The examiner's proposed combination

of McNally '418 and Miyamoto '364 fails to teach the features set forth in independent claims 2, 6-9, 21, 26, 31, 36, and 43.

Obviousness can only be established by combining or modifying the teachings of the cited art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); M.P.E.P. § 2143.01.

When applying 35 U.S.C. § 103, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. *Hodosh v. Block Drug Co., Inc.* 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187, n.5 (Fed. Cir. 1986); M.P.E.P. § 2141.

The applicant is aware that “[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.” *In re McLaughlin* 443 F.2d 1392, 170 USPQ 209, 212 (CCPA 1971); M.P.E.P. § 2145. The examiner here has utilized **impermissible** hindsight reasoning, because the examiner has relied upon knowledge gleaned from the applicant's disclosure.

The teaching or suggestion to make the claimed combination and the reasonable expectation

of success must both be found in the cited art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2143.

“While the [prior art] apparatus may be capable of being modified to run the way [the applicant's] apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 16 USPQ2d 1430, 1432; M.P.E.P. § 2143.01. “The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The law under 35 U.S.C. § 103 is well settled that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *ACS Hospital System, Inc v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The examiner must point to something in the cited art that suggests in some way a modification of a particular reference or a combination of references in order to arrive at applicant's claimed invention. Absent such a showing, the examiner has improperly used applicant's disclosure as an instruction book on how to reconstruct the cited art to arrive at applicant's claimed invention. The examiner has wrongly used knowledge gleaned only from the applicant's disclosure to reach the examiner's conclusion of obviousness.

It is clear that the examiner has failed to establish that the teachings from the cited art itself would have suggested the claimed subject matter to a person of ordinary skill in the art, and it is

clear that the examiner has used impermissible hindsight to combine and modify the cited art references.

If an independent claim is not anticipated by a particular reference, then any claim depending from that independent claim is also not anticipated by the particular reference. This is true because the claims depending from that independent claim necessarily incorporate all limitations set forth in that independent claim. Accordingly, in view of the foregoing, the applicant respectfully requests that the examiner allow all claims 2, 6-9, and 21-50.

The examiner has not satisfied the requirements set forth in 35 U.S.C. § 103 and M.P.E.P. § 2143 regarding a rejection of claims based on obviousness.

The examiner has failed to establish the aforementioned **first** basic criterion of a *prima facie* case of obviousness because the examiner failed to show that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, in accordance with M.P.E.P. § 2143 and 35 U.S.C. § 103, to arrive at the applicant's claimed invention. There is no reasonable suggestion or motivation to combine McNally '418 and Miyamoto '364 in order to arrive at the applicant's claimed invention. In addition, there is no reasonable suggestion or motivation to modify McNally '418 and Miyamoto '364 in order to arrive at the applicant's claimed invention.

Also, the examiner has failed to establish the aforementioned **second** basic criterion of a

prima facie case of obviousness because the examiner failed to show that there would be a reasonable expectation of success as a result of the examiner's proposed combination of cited art. Furthermore, the examiner has failed to establish the aforementioned **third** basic criterion of a *prima facie* case of obviousness because the examiner failed to show that McNally '418 and Miyamoto '364 teach or suggest all the claim limitations of claims 2, 6-9, and 21-50. The examiner has failed to establish a *prima facie* case of obviousness because the examiner failed to show that the references teach or suggest all the claim limitations.

The foregoing shows that the examiner has failed to establish a *prima facie* case of obviousness. In view of the noted deficiencies of McNally '418, the inability of Miyamoto '364 to remedy the noted deficiencies of McNally '418, and the unlikely combination and modification as proposed, the applicant respectfully submits that the rejection of claims 2, 6-9, and 21-50 is improper.


Accordingly, in view of the foregoing, the applicant respectfully requests that the claims 2, 6-9, and 21-50 be allowed.

Numerous references were cited by the examiner on page 4 of Paper No. 9 but not utilized in the rejection of the claims. As recognized by the examiner, these references fail to teach or suggest the specifically recited features of the present invention and accordingly, no further comment on these references is necessary.

No fee is incurred by this response.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the examiner is requested to telephone applicant's attorney.

Respectfully submitted,


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